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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,477	06/21/2005	Scott Eugene Conner	X-15460	2986

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ELI LILLY & COMPANY
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EXAMINER

NOLAN, JASON MICHAEL

ART UNIT	PAPER NUMBER
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1626

NOTIFICATION DATE	DELIVERY MODE
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08/07/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@lilly.com

Office Action Summary	Application No. 10/539,477	Applicant(s) CONNER ET.AL.	
	Examiner Jason M. Nolan, Ph.D.	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5-40,42-59,61-63 and 65-72 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5,48,58,59,71 and 72 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 1,6-9,15,18,21-23,27,28,30-33,35,44,49,50,54,57 and 61 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/21/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims withdrawn from consideration are 3,10-14,16,17,19,20,24-26,29,34,36-40,42,43,45-47,51-53,55,56,62,63 and 65-70.

DETAILED ACTION

Claims 1, 3, 5-40, 42-59, 61-63 & 65-72 are pending in the instant application; of which **Claims 3, 10-14, 16, 17, 19, 20, 24-26, 29, 34, 36-40, 42, 43, 45-47, 51-53, 55, 56, 62, 63 & 65-70** are withdrawn from further consideration as being drawn to a non-elected invention. Therefore, **Claims 1, 5-9, 15, 18, 21-23, 27, 28, 30-33, 35, 44, 48-50, 54, 57-59, 61, 71 & 72** are examined herein.

Response to Restriction

Applicants' election with traverse of **Group IV** is acknowledged. The traversal suggests that the method of use (**Claim 61**), which is commensurate in scope with the elected product claims, such be examined too. In response, Applicants' request to included **Claim 61** in the elected group has been considered and accepted.

Claim Objections

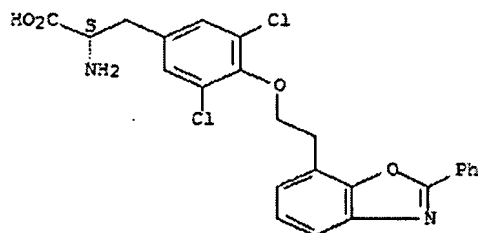
Claims 1, 35 & 44 are objected to because of the following informalities: said claims contain the variable **R1**, which has no place to be a substitute on a fused bicyclic thiazole or oxazole. Further, **R2** is C₀, therefore it is a bond and the phenyl moiety should be connected to the two position of formula in **Claims 1 & 44**. Both corrections would help clarify the structure for any reader. Further, the claims should be amended to delete the non-elected subject matter (which includes in this case the variables **R1** and **R2**). Appropriate correction is required.

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Claims 7-9, 15, 18, 21-23, 27, 28, 30-33, 35, 49-50, 54, 57 & 61 are objected to for the following informality: there should be a space between the word "claim" and the claim number "#" in each circumstance. **Claim 6** should be amended to depend on "claim 1" not "claims 1". Appropriate correction is required.

Allowable Subject Matter

The present invention pertains to the compounds and compositions according to the formula in **Claim 1** and methods of using these compounds for the treatment of diabetes. The compounds according to formula I are free of the prior art; nothing known in the art anticipates or renders the compounds of the instant application obvious. The closest prior art related to the formula I is compound RN 579524-13-3, taught by Endo *et al.* (WO 2003066574 A1, 08/14/2003). Compound RN 579524-13-3, shown below, fulfills all of the limitations of said formula with the exception of $R^{3 \text{ or } 4}$, which is an amino moiety. In the instant application, $R^{3 \text{ or } 4}$ can be a hydrogen atom, a substituted or unsubstituted alkyl, or the alkyls can combine to form a ring.



One skilled in the art would be enabled to make and use the compounds taught herein for the purpose of treating diabetes using the teachings of the Specification

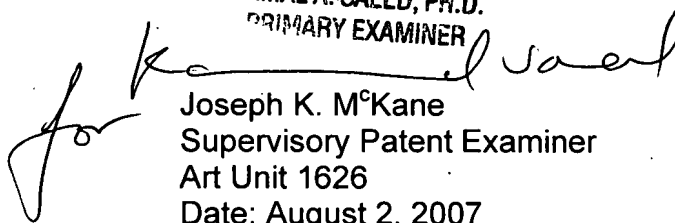
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(assays on pages 240-255) in conjunction with the teachings in the prior art (see Rami *et al. Expert. Opin. Ther. Patents*, **2000**, 10(5), 623-634, cited in IDS).

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jason M. Nolan, Ph.D.** whose telephone number is **(571) 272-4356** and electronic mail is **Jason.Nolan@uspto.gov**. The examiner can normally be reached on Mon - Fri (9:00 - 5:30PM). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Joseph M^cKane** can be reached on **(571) 272-0699**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jason M. Nolan, Ph.D.
Examiner
Art Unit 1626

KAMAL A. SAEED, PH.D.
PRIMARY EXAMINER

Joseph K. M^cKane
Supervisory Patent Examiner
Art Unit 1626
Date: August 2, 2007